REMARKS

I. Background

The present Amendment is in response to the Office Action mailed April 6, 2006. Since claims 13-19, 21, and 22 have been previously withdrawn, claims 1-12, 20, and 23 were pending in the application for consideration at the time of the mailing of the Office Action. Claims 1, 20, and 23 are currently amended. Claims 1-12, 20, and 23 are still pending for consideration.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

II. Proposed Claim Amendments

Please amend the claims in the manner indicated above, where an underline represents new text, and strikeouts are used to indicate deleted text. The amendments to claims 1, 20, and 23 have been made to place the claims in condition for allowance, and are fully supported by the application as originally filed. Thus, Applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

III. Rejections on the Merits

A. Rejections Under 35 U.S.C. § 103

The Office Action has rejected claims 1-12, 20, and 23 under 35 U.S.C. § 103(b) as being unpatentable over *Su et al.* (U.S. Appl. No. 2002/0068102) in view of *Fischer et al.* (U.S. Pat. No. 5,433,965) or *Downton et al.* (U.S. Pat. No. 5,411,755). Applicant respectfully traverses because the Office Action has not established a *prima facie* case of obviousness.

According to the applicable law, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references *teach or suggest* all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." (emphasis added).

The present invention claims a dietary supplement comprising noni fruit powdered Luo Han Guo. Claim 1 is representative of the supplement's composition: "[a] dietary supplement comprising: noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the

noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo." As recited in the specification, Luo Han Guo has two different extracts with separate and distinct properties: liquid Luo Han Guo extract provides sweetening and powdered Luo Han Guo extract provides flavor masking. That is, liquid Luo Han Guo extract is added as a sweetening agent and powdered Luo Han Guo extract is added to mask the unfavorable flavor and/or scent of the noni fruit. Applicant respectfully asserts that the different characteristics of the liquid and powdered extracts of Luo Han Guo had been previously unknown with respect to the ability to provide the liquid extract for sweetening and the powdered extract for masking the flavor and/or scent of noni fruit.

Additionally, **Applicant respectfully asserts that sweetening is a characteristic separate and distinct from masking an unfavorable flavor and/or scent**. That is, a composition having an unfavorable flavor and/or scent can be sweetened, but still retain the unfavorable flavor and/or scent. While additional sweeteners can be added, there is no indication that the sweetener can mask the unfavorable flavor and/or scent. As such, liquid extract of Luo Han Guo may be used as a sweetener; however, the liquid extract of Luo Han Guo does not have any flavor and/or scent masking properties. On the other hand, the previously unidentified property of the powdered extract of Luo Han Guo has now been found to be useful in masking the unfavorable flavor and/or scent of noni fruit. Applicant respectfully points out that a composition containing noni fruit or any other substance with an unfavorable taste and/or smell can be sweet while still having an unfavorable taste and/or smell. Thus, Applicant has overcome the problem of noni fruit compositions having an unfavorable taste and/or smell by mixing powdered extract of Luo Han Guo into the composition with the noni fruit.

Su teaches a dietary supplement comprising noni juice, and acknowledges the well-known tendency for ripe or overripe noni to have a "foul odor and/or taste" (*Su*, paragraph 25) However, *Su* is completely devoid of teaching or suggesting that the "foul odor and/or taste" can in any way be masked. Additionally, *Su* does not teach a dietary supplement comprising "noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo," as recited in claim 1. As such, *Su* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition, and does not provide

any motivation or suggestion for modifying the noni fruit composition to include a flavor and/or smell masking agent such as the powdered extract of Luo Han Guo.

Fischer is completely devoid of teaching or suggesting that Luo Han Guo can be used to mask an unfavorable flavor and/or scent. That is, *Fischer* does not teach that Luo Han Guo can be used to mask the flavor and/or scent of anything. Fischer teaches sweetening with a liquid extract of Luo Han Guo, but, as was pointed out above, sweetening is not the same as flavor and/or scent masking. Further, *Fischer* is completely devoid of teaching a dietary supplement that includes "noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo," as recited in claim 1. In fact, *Fischer* teaches away from the use of the powdered extract of Luo Han Guo because of the so-called "bitter, astringent, and brown flavors" associated with the drying process that is a precursor to making the powdered form of the fruit (Column 1, lines 55-56). As such, *Fischer* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition, and does not provide any motivation or suggestion for using the powdered extract of Luo Han Guo as a flavor and/or scent masking agent for noni fruit.

Downton, like *Fischer*, is completely devoid of teaching or suggesting that Luo Han Guo can be used to mask an unfavorable flavor and/or scent. In fact, *Downton* does not teach that Luo Han Guo can be used to mask the flavor and/or scent of anything. And while *Downton* teaches sweetening with liquid extracts of Luo Han Guo, Applicant once again respectfully asserts that sweetening is not the same as flavor and/or scent masking. Further, *Downton* is completely devoid of teaching a dietary supplement that includes "noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo," as recited in claim 1. *Downton*, like *Fischer*, teaches away from the use of a powdered extract of Luo Han Guo because of the so-called "bitter, astringent, and brown flavors" associated with the drying process that is a precursor to making the powdered form of the fruit (Column 1, lines 64-65). As such, *Fischer* is completely devoid of teaching or suggesting a dietary supplement having the presently claimed composition, and does not provide any motivation or suggestion for using the powdered extract of Luo Han Guo as a flavor and/or scent masking agent for noni fruit.

1. No Suggestion or Motivation for Combination

Applicant respectfully asserts that there is no suggestion or motivation arising from *Su* and *Fischer* or *Downton*, alone or in combination, to make such a combination of references. The Court of Appeals for the Federal Circuit has consistently required some suggestion or motivation to combine references because "[t]he genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion or reason' to combine cited references." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997)).

As applicant has respectfully pointed out, the ability to sweeten a composition with a liquid extract of Luo Han Guo is separate and distinct from the ability to mask the unfavorable flavor and/or scent of noni fruit with a powdered extract of Luo Han Guo. While *Su* acknowledges the well-known tendency for ripe or overripe noni fruit to have a "foul odor and/or taste," *Su* is devoid of teaching or suggesting that the "foul odor and/or taste" of noni fruit can be masked. Moreover, this acknowledgement does not provide any motivation, suggestion, or reason to combine the noni fruit with the sweetener or sweet juice composition described in *Fischer* or *Downton* because ***Fischer* and *Downton* are completely devoid of the teaching or suggesting that liquid Luo Han Guo can be used to mask a bad flavor and/or scent in anything**. Furthermore, ***Fischer* and *Downton* do not teach or suggest that powdered Luo Han Guo can be used to mask bad flavor and/or scent in anything**. *Fischer* and *Downton* merely teach similar liquid Luo Han Guo extracts intended for use as sweetening agents. That is, *Fischer* and *Downton* only teach the use of a liquid extract of Luo Han Guo as a sweetener, and they do not teach the use of a powdered extract of Luo Han Guo to mask an unfavorable flavor and/or scent. Thus, there is no motivation to combine *Su* and *Fischer* or *Downton* because *Su* does not teach or suggest that the foul odor or taste of noni fruit can be masked, and *Fischer* and *Downton* are completely devoid of teaching or suggesting a powder extract of Luo Han Guo that can be used to mask the flavor and/or scent of noni fruit.

2. Combination Does Not Teach Each Claim Limitation

Applicant respectfully asserts that the combination of *Su* and *Fischer* or *Downton* does not teach each and every claim limitation of the presently claimed invention. Specifically, ***Su* and *Fischer* or *Downton* do not teach that a powdered extract of Luo Han Guo can be used to mask the flavor and/or scent of the noni fruit utilized in the dietary supplement or the dietary supplement itself**. As such, none of the references, alone or in combination, teach or suggest a dietary supplement comprising "noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo, as recited in claim 1. Since none of *Su* and *Fischer* or *Downton* teach or suggest a powdered extract of Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, each and every element of the presently pending claims has not been taught or suggested by the proposed combination of references.

3. Teaching Away

Applicant respectfully asserts that both *Fischer* and *Downton* teach away from the use of powdered Luo Han Guo extract. Powdered extract of Luo Han Guo is made from dried Luo Han Guo fruit. (See, e.g., *Fischer*, Col. 1, lines 45-46). *Fischer* and *Downton* specifically state that the drying process that occurs prior to powdering "causes the formation bitter, astringent, and brown flavors." (*Fischer*, Col. 1, lines 53-59; *Downton*, Col. 1, lines 63-68, emphasis added). Furthermore, the final product of the processes taught by *Fischer* and *Downton* is a sweet liquid that is free of all of the so-called "unattractive" flavors inherent in a powdered extract of Luo Han Guo (see, e.g., *Fischer*, col. 2, lines 13-15, and col. 2, lines 36-38). The liquid extract of Luo Han Guo taught by *Fischer* and *Downton* is suitable only for sweetening. Thus, ***Fischer* and *Downton* both teach away from the presently claimed invention because of the undesirability of using a powdered extract of Luo Han Guo due to the "bitter, astringent, [or] brown flavors**."

Since there is no suggestion or motivation arising from *Su* and *Fischer* or *Downton* to make the proposed combination of references, the combination of *Su* and *Fischer* or *Downton* does not teach or suggest each and every element of the claims, and *Fischer* and *Downton* teach

away from the use of powdered extract of Luo Han Guo, a *prima facie* case of obviousness has not been established with respect to claim 1 as discussed above. Additionally, claims 2-12 depend from claim 1, and thereby are allowable for the same reasons claim 1 is allowable. Moreover, independent claims 20 and 23 both recite that the powdered extract of Luo Han Guo is combined with noni fruit to mask the flavor and/or scent of the noni fruit, and thereby are allowable for substantially the same reasons as claim 1. As such, Applicant respectfully requests that the rejection of claims 1-12, 20, and 23 be withdrawn.

B. Rejections Under 35 U.S.C. § 103

The Office Action has rejected claims 1-12, 20, and 23 under 35 U.S.C. § 103(b) as being unpatentable over *Yegorova et al.* (U.S. 6,387,370) in view of *Fischer et al.* (U.S. 5,433,965 or *Downton et al.* (U.S. 5,411,755). Applicant respectfully traverses because the Office Action has not established a *prima facie* case of obviousness.

Yegorova teaches compositions that include noni and various fruit juices and other fruit extracts such as "red wine extract, prune extract, blueberry extract, pomegranate extract, apple extract, and an enzyme mixture." However, *Yegorova* is completely devoid of teaching or suggesting that noni fruit has an offensive flavor and/or scent. Additionally, *Yegerova* is completely devoid of teaching or suggesting that noni fruit has an offensive flavor and/or scent that can be masked by anything. Moreover, *Yegerova* does not teach a dietary supplement comprising "noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo," as recited in claim 1. As such, *Yegorova* is completely devoid of teaching a dietary supplement having the presently claimed composition.

1. No Suggestion or Motivation for Combination

Applicant respectfully asserts that there is no suggestion or motivation arising from *Yegerova* and *Fischer* or *Downton*, alone or in combination, to make such a combination of references. *Yegerova* does not cure any of the deficiencies manifest in the combination of *Su* and *Fischer* or *Downton* discussed above. *Yegerova* does not teach that or suggest that noni fruit has an offensive taste and/or order, nor does it teach or suggest that the offensive flavor and/or scent of noni can be masked. Thus, there is no suggestion or motivation to combine *Yegerova* and

Fischer or *Downton* for all of the same reasons discussed above in connection with the combination of *Su* and *Fischer* or *Downton*

2. Combination Does Not Teach Each Claim Limitation

Applicant respectfully asserts that the combination of *Yegerova* and *Fischer* or *Downton* does not teach each and every claim limitation of the presently claimed invention. *Yegerova* does not cure any of the deficiencies discussed regarding the combination of *Su* with *Fischer* or *Downton*. As with *Su* and *Fischer* or *Downton*, the combination *Yegerova* and *Fischer* or *Downton* does not teach each and every element of the presently pending claims.

3. Teaching Away

Again, Applicant respectfully asserts that both *Fischer* and *Downton* teach away from the use of powdered Luo Han Guo extract.

Since there is no suggestion or motivation arising from *Yegerova* and *Fischer* or *Downton* to make the proposed combination of references, the combination of *Yegerova* and *Fischer* or *Downton* does not teach or suggest each and every element of the claims, and *Fischer* and *Downton* teach away from the use of powdered extract of Luo Han Guo, a *prima facie* case of obviousness has not been established with respect to claim 1 as discussed above. Additionally, claims 2-12 depend from claim 1, and thereby are allowable for the same reasons claim 1 is allowable. Moreover, independent claims 20 and 23 both recite that the powdered extract of Luo Han Guo is combined with noni fruit to mask the flavor and/or scent of the noni fruit, and thereby are allowable for substantially the same reasons as claim 1. As such, Applicant respectfully requests that the rejection of claims 1-12, 20, and 23 be withdrawn.

CONCLUSION

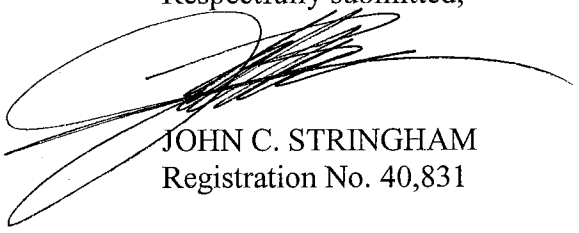
In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

Applicant believes claims 1-12, 20, and 23 are in allowable form as discussed above. Thus, Applicant respectfully requests reconsideration of the application and allowance of presently pending claims.

In view of the foregoing, Applicant respectfully requests favorable reconsideration and allowance of the present claims. In the event the Examiner finds any remaining impediment to the prompt allowance of this application which could be clarified by a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney.

Dated this 5 day of June, 2007.

Respectfully submitted,



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